



Serial No.: 09/777,492
Docket No.: 773919-0511

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF

Inventor : Stephen B. Bove, et al.
Serial No. : 09/777,492
Filing Date : February 5, 2001
Title : SYSTEM AND METHOD FOR ANONYMOUS
LEAD GENERATION AND MANAGEMENT

Group/Art Unit : 3695
Confirmation No. : 8359
Examiner : Siegfried E. Chencinski

Docket No. : 773919-0511

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In accordance with the provisions of 37 C.F.R. § 41.41, Appellant submits this Reply
Brief in response to the Examiner's Answer mailed on December 10, 2008.

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REMARKS

In the Examiner's Answer mailed on December 10, 2008, the Examiner withdrew the following rejections: (1) that claim 21 was not directed to statutory subject matter; (2) that claims 1 and 9 did not comply with the written description requirement; (3) that claims 1 and 9 are incomplete for omitting essential steps; and (4) that claims 1, 9, and 16 lack antecedent basis for "transmitting said proposal" and "anonymously submitted database search criteria."

The Examiner maintained the rejection of: (1) independent claims 1, 9, and 16 as being obvious over U.S. Patent Number 6,574,608 to Dahod et al. ("Dahod") in view of U.S. Patent No. 6,868,389 to Wilkins et al. ("Wilkins"), and (2) independent claim 21 as being obvious over Dahod in view of U.S. Patent Application Publication Number 2002/0169626 to Walker et al. ("Walker"). This Reply Brief addresses the arguments from the Examiner's Answer with respect to these rejections of the independent claims. Because the patentability of the dependent claims was not specifically argued in the Amended Appeal Brief or the Examiner's Answer, the dependent claims are not addressed in this Reply Brief.

I. Independent claims 1, 9, and 16 are not obvious over Dahod in view of Wilkins.

The patentability of independent claims 1, 9, and 16 is asserted at Section VII, Part 5 (pp.14-17) of the Amended Appeal Brief. The Examiner's Answer responds to Appellant's arguments with respect to these claims at Response E, pages 13-15.

A. Each of claims 1, 9, and 16 requires anonymity, and both Dahod and Wilkins do not disclose anonymity.

The Examiner asserts that claims 1, 9, and 16 do not require anonymity. Ex's Ans. p. 13, Resp. E, Sub-Arg. 1(a). This assertion is incorrect. Each of these claims requires anonymity. Specifically, claim 1 requires "maintaining a prospect database identifying device-identifying information and corresponding prospect information comprising: prospect-identifying

information, *anonymously submitted search criteria*, and search information corresponding to said search criteria". (emphasis added). Similarly, independent claim 9 requires "a database for storing prospects having *anonymously submitted search criteria*," and independent claim 16 requires the step of "generating a prospect having *anonymously submitted search criteria*." (emphasis added).

The Examiner also states that Appellant's argument that Dahod and Wilkins do not disclose anonymity is moot because Appellant has not provided the combination of evidence and rationale required for a valid traversal. Ex's Ans. p.14, Resp. E, Sub-Arg. 1(c). Appellant has provided sufficient evidence because as stated in the Amended Appeal Brief at pages 15-16, the system of Dahod requires registration of buyers and sellers (Dahod, Col. 5, Lines 7-21), and the system of Wilkins requires user-identifying cookies (Wilkins, Col. 2, Lines 49-51). Thus, neither of these references discloses anonymity as required by each of claims 1, 9, and 16. Accordingly, claims 1, 9, and 16 are not obvious in view of the combination of these references. In view of the arguments herein, Appellant respectfully requests that the Board reverse the Examiner's rejection of these claims.

B. Combining the systems of Dahod and Wilkins renders each unsatisfactory for its intended purpose.

There is no suggestion or motivation to modify the teaching of one reference with the teachings of another when the proposed modification renders the prior art unsatisfactory for its intended purpose. MPEP 2143.01 Part V. As described in the Amended Appeal Brief, the combination of Dahod and Wilkins renders each unsatisfactory for its intended purpose. App. Br. pp.15-16. Because Dahod and Wilkins must be considered as a whole and the combination of Dahod and Wilkins renders each unsatisfactory for its intended purpose, it would not have been obvious to combine Dahod with Wilkins to arrive at the claimed limitations.

In the Examiner's Answer, the Examiner makes the following erroneous statement of law:

Combination of specific method steps from a plurality of references in business methods only combines the specific steps and does not drag with it any other component of the references because they are not needed for Appellant's invention and are not needed in making use of the specific tasks in the limitation. The reason is that there is no technical reason for the other components to come with the narrow teaching(s) used by the examiner in the rejection(s). When such tie ins exist they are scientific phenomena where a broader chain of things has to be taken together because there is no known way of separating the elements, such as those of certain chemical reactions.

Ex's Ans. pp.13-14, Resp. E, Sub-Arg. 1(b). The two cases that the Examiner cites for this proposition, W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983) and In re Gurley, 27 F.3d 551 (Fed. Cir. 1994), do not support the Examiner's statement.

The Examiner's statement is actually directly contrary to W.L. Gore & Associates and MPEP 2141.02 Part VI. While the Examiner states that individual steps from references may be combined without considering the teachings of the references as a whole, W.L. Gore & Associates states that is an error to "consider[] references in less than their entireties." Id. at 1550. In re Gurley also cites W.L. Gore & Associates for the proposition that "the totality of a reference's teachings must be considered." In re Gurley, 27 F.3d at 553. Therefore, the Examiner erred in only considering specific steps from the cited references without considering the references as a whole. The Examiner's statement also implies that claims directed toward business methods are treated differently in this respect than claims directed toward other statutory subject matter. Ex's Ans. p.13-14. There is no precedent for the Examiner's suggestion that one can combine steps from business method references without considering the references as a whole.

Because the combination of Dahod and Wilkins renders each unsatisfactory for its intended purpose, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 1, 9, and 16.

C. Both Dahod and Wilkins teach away from the present invention.

The Examiner states that Appellant's argument that Dahod and Wilkins teach away from the present invention is moot because the combination of specific evidence and rationale required for a valid traversal was not provided. Ex's Ans. p.14, Resp. E, Sub-Arg. 1(d). The Examiner is incorrect because page 16 of the Amended Appeal Brief provides sufficient argument as to why both Dahod and Wilkins teach away from the present invention. The Amended Appeal Brief states that because Dahod "requir[es] registration by users" and because Wilkins uses "user-identifying cookies" that both "teach away from the anonymous lead generation system claimed in the present invention." App. Br. p.16.

Next, the Examiner states that the statement quoted above in Section I, Part B of this Brief is applicable to rebut Appellant's teaching away argument. As described above, the above quoted statement by the Examiner is not an accurate representation of the law. Thus, it is not applicable to Appellant's teaching away argument.

The Examiner also provides a brief description of W.L. Gore & Associates and In re Gurley in support of his rebuttal of Appellant's teaching away argument. Ex's Ans. p.14-15. In an attempt to apply the teachings of these cases to the claims of the present application, the Examiner makes the following statement: "In this case, It becomes clear that, contrary to Appellant's assertion, trends not cited in the reference as teaching away in a manner relevant to the specific use of the Dahod's disclosures from being modified to meet Appellant's limitations." While Appellant does not know how to specifically respond to this statement by the Examiner,

neither of these cases support the Examiner's position. W.L. Gore & Associates actually supports Appellant's argument because the court held that the claimed invention was not obvious where it "proceeded contrary to the accepted wisdom of the prior art." Id. at 1553.

Likewise, In re Gurley does not support the Examiner's argument. While the court in In re Gurley held the claims obvious in view of the cited reference, the facts of In re Gurley are distinguishable from the present facts. The cited reference in In re Gurley actually disclosed the claimed epoxy resin while describing that it was inferior to another type of polyester-imide resin. Id. at 552-53. The court stated that: "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." Id. at 553. Here, neither Dahod nor Wilkins discloses the claimed anonymity. Rather, Dahod "requir[es] registration by users" (Dahod, Col. 5, Lines 7-21) and Wilkins uses "user-identifying cookies" (Wilkins, Col. 2, Lines 49-51). Therefore, both Dahod and Wilkins teach away from the claimed invention.

Because Dahod and Wilkins both teach away from the claimed invention, claims 1, 9, and 16 are not obvious in view of Dahod and Wilkins.

II. Independent claim 21 is not obvious over Dahod in view of Walker.

The patentability of independent claim 21 is asserted at Section VII, Part 8 (pp.18-19) of the Amended Appeal Brief. The Examiner's Answer responds to Appellant's arguments with respect to claim 21 at Response H, pages 16-18.

A. Both Dahod and Walker teach away from claim 21.

The Examiner states that the principles identified in his teaching away argument with respect to claims 1, 9, and 16 also apply to rebut Appellant's argument that both Dahod and Walker teach away from claim 21. Ex's Ans. p.16, Resp. H, Sub-Arg. 1. As stated above in

Section I, Part C of this Brief, neither of the cases cited by the Examiner, W.L. Gore & Associates or In re Gurley, support the Examiner's position.

Because both Dahod and Walker require user registration as described on page 18 of the Amended Appeal Brief, both references teach away from the limitations of claim 21. Accordingly, claim 21 is not obvious in view of Dahod and Walker.

B. Dahod does not teach "storing search criteria in association with search-requester information."

Dahod does not disclose storing search criteria in association with search-requester information as required by claim 21. While Dahod discloses that sellers (not buyers) can search the listings posted by the buyers (see Dahod, Col. 6, Lines 29-34), there is no disclosure in Dahod that the results of that search or the search criteria be stored in association with search-requester information as is required in claim 21 of the present application. Dahod simply allows searching of posted listings. The search results and the search criteria are not then stored and used to generate prospects and proposals.

With respect to Dahod the Examiner states that "[t]he counter-party's response could not find itself back to the party which had posted the offer to sell or the interest in buying a given product or service" without storing search criteria. Ex's Ans. pp.16-17, Resp. H, Sub-Arg. 2. While Dahod stores listings posted by buyers and allows potential sellers to search those buyer-posted listings, the results of the seller's search are not stored in association with search-requester information to allow prospect generation from the search results. Accordingly, Dahod does not disclose storing search criteria as required by claim 21. In view of this Appellant respectfully requests the Board to reverse the Examiner's rejection of claim 21.

C. Both Dahod and Walker do not disclose storing search criteria without a requirement of user registration.

The Examiner states that "Dahod does indeed disclose storing search criteria without a requirement of user registration." Ex's Ans. p.17, Resp. H, Sub-Arg. 3. The Examiner is incorrect. As described above in Section I, Part A of this Brief and in the Amended Appeal Brief at pages 15-16 and 18, Dahod requires users to register in order to receive proposals from the system. Dahod, Col. 5, Lines 7-21.

The Examiner also states that Appellant has not offered any combination of evidence and sufficient rationale in support of Appellant's assertion that both Dahod and Walker do not disclose storing search criteria without a requirement of user registration. Ex's Ans. p.17. The Amended Appeal Brief at page 18 specifically states that Dahod requires users to register (Dahod, Col. 5, Lines 7-21) and that Walker requires that merchants register their contact information in the system (Walker, Fig. 9 & ¶ [0062]). Therefore, Appellant has provided sufficient evidence in support of this assertion.

The Examiner states that Walker discloses storing search criteria without a requirement of user registration because while Walker requires sellers, agents, and reference providers to register, Walker does not require consumers to register. Ex's Ans. p.17. The Examiner is incorrect. Fig. 7 of Walker and paragraph [0048] disclose that prospective customers must register their information, which is stored in a database to facilitate communication between the customers, merchants, and reference providers.

The Examiner also cites KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007) and In re Kahn, 441 F.3d 977 (Fed. Cir. 2006) for the proposition that all of the claim's limitations do not need to be disclosed in the cited references if a person having ordinary skill in the art would have viewed the limitations as obvious in view of the cited references. Ex's Ans. pp.17-18. As noted

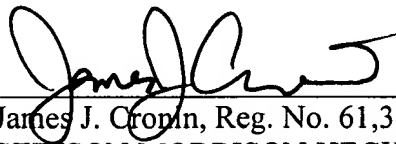
by the Examiner, the Supreme Court in KSR stated that "[t]o facilitate review, this analysis should be made explicit." Id. at 1741. Here, the Examiner has failed to set forth any rationale as to why claim 21 would be obvious in view of Dahod and Walker when even the references do not disclose all of the limitations of claim 21. Thus, the Examiner has failed to follow the teachings of KSR and In re Kahn that he cited in the Examiner's Answer.

Because both Dahod and Walker do not disclose storing search criteria without a requirement of user registration, and Dahod and Walker teach away from this requirement, Appellant respectfully requests that the Board reverse the Examiner's rejection of claim 21.

* * *

For the foregoing reasons, and the reasons set forth in Appellant's Amended Appeal Brief, Appellant submits that independent claims 1, 9, 16, and 21 (and thus dependent claims 2-8, 10-15, 17-20, and 22-25) are patentable over the cited references and should be allowed. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejections and allow claims 1-25 of the present application.

Respectfully submitted,

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